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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,326	08/31/2001	Rachel Meyers	MPI00-344P1RM	2458

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Intellectual Property Group  
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EXAMINER  
YU, MISOOK

ART UNIT	PAPER NUMBER
1642	

DATE MAILED: 11/10/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/945,326

Applicant(s)

MEYERS ET AL.

Examiner

MISOOK YU, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 41-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6,7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

Claims 41-49 are pending and examined on merits.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 41-49 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. While all of the technical details of a method need not be recited, the claims should include enough information to clearly and accurately describe the invention and how it is to be practiced. The minimum requirements for method steps minimally include a contacting step in which the reaction of the sample with the reagents necessary for the assay is recited, a detection step in which the reaction steps are quantified or visualized, and a correlation step describing how the results of the assay allow for the determination. The omitted steps are: a correlation step describing how determining cellular growth or proliferation of the cancer cells allow for the determination of which compound is capable of treating cellular growth, proliferative disorder, or cancer.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 41-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This rejection has several aspects.

First, the claims refer to a particular ATCC deposit, therefore access to that deposit is required to practice the invention. As a required element it must be known and readily available to the public or obtainable by a repeatable method set forth in the specification, or otherwise readily available to the public. If it is not so obtainable or available, the enablement requirements of 35 U.S.C. § 112, first paragraph, may be satisfied by a deposit of the cell lines listed in claim 7. See 37 CFR 1.802.

The specification does not provide a repeatable method for obtaining the biological material and they do not appear to be readily available material. Deposit of the biological material would satisfy the enablement requirements of 35 U.S.C. 112.

If a deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his or her signature, stating that the deposit has been made under the terms of the Budapest Treaty and that all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent, would satisfy the deposit requirements. See 37 CFR 1.808.

If a deposit is not made under the terms of the Budapest Treaty, then an affidavit or declaration by applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his or

her signature, stating that the deposit has been made at an acceptable depository and that the following criteria have been met:

- (a) during the pendency of this application, access to the invention will be afforded to one determined by the Commissioner to be entitled thereto;
- (b) all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon granting of the patent;
- (c) the deposit will be maintained for a term of at least thirty (30) years and at least five (5) years after the most recent request for the furnishing of a sample of the deposited material;
- (d) a viability statement in accordance with the provisions of 37 CFR 1.807; and
- (e) the deposit will be replaced should it become necessary due to inviability, contamination or loss of capability to function in the manner described in the specification.

In addition the identifying information set forth in 37 CFR 1.809(d) should be added to the specification. See 37 CFR 1.803 - 37 CFR 1.809 for additional explanation of these requirements.

If a deposit is made after the effective filing date of the application for patent in the United States, a verified statement is required from a person in a position to corroborate that the biological material described in the specification as originally filed is the same as that deposited in the depository, stating that the deposited material is

identical to the biological material described in the specification and was in the applicant's possession at the time the application was filed.

Applicant's attention is directed to In re Lundak, 773 F.2d. 1216, 227 USPQ 90 (CAFC 1985) and 37 CFR 1.801-1.809 for further information concerning deposit practice.

Second, the preamble of the claims says that instant invention is drawn to method of finding a compound capable of treating cancer. The specification does not teach any compound identified by the instantly claimed method is capable of treating any of the diseases listed in the claims. One cannot extrapolate the teaching of the specification to the claim because it is well known that the art of anticancer drug discovery for cancer therapy is highly unpredictable, for example, Gura (Science, 1997, 278:1041-1042) teaches that researchers face the problem of sifting through potential anticancer agents to find ones promising enough to make human clinical trials worthwhile and teach that since formal screening began in 1955, many thousands of drugs have shown activity in either cell or animal models but that only 39 have actually been shown to be useful for chemotherapy (p. 1041, see first and second para). Further, the refractory nature of cancer to drugs is well known in the art. Jain (Sci. Am., 1994, 271:58-65) teaches that tumors resist penetration by drugs (p.58, col 1) and that scientists need to put expanded effort into uncovering the reasons why therapeutic agents that show encouraging promise in the laboratory often turn out to be ineffective in the treatment of common solid tumors (p. 65, col 3). Curti (Crit. Rev. in Oncology/Hematology, 1993, 14:29-39) teaches that solid tumors resist destruction by

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chemotherapy agents and that although strategies to overcome defense mechanisms of neoplastic cells have been developed and tested in a number of patients, success has been limited and further teaches that it is certainly possible that cancer cells possess many as yet undefined additional molecular mechanisms to defeat chemotherapy treatment strategies and if this is true, designing effective chemotherapeutic regimens for solid tumors may prove a daunting task (para bridging pages 29-30) and concludes that knowledge about the physical barriers to drug delivery in tumors is a work in progress (p. 36, col 2). It is clear that based on the state of the art, in the absence of experimental evidence, one skilled in the art would not accept that going through the active steps of the instant claims would successfully lead to identifying a compound capable of treating cancer. In addition, Hartwell et al (Science, 1997, 278:1064-1068) teach that an effective chemotherapeutic must selectively kill tumor cells, that most anticancer drugs have been discovered by serendipity and that the molecular alterations that provide selective tumor cell killing are unknown and that even understanding the detailed molecular mechanism by which a drug acts often provides little insight into why the treated tumor cell dies (para bridging pages 1064-1065) and Jain (cited supra) specifically teaches that systemic treatment typically consists of chemotherapeutic drugs that are toxic to dividing cells (p. 58, col 2, para 2).

Third, the claims are not enabled because the specification fails to teach how to make a fragment of SEQ ID NO:2 or a protein 95 % identical to SEQ ID NO:2 with a dehydrogenase activity. The entire specification is about inventors' discovery of a new gene encoding a putative dehydrogenase based on homology. The specification does

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not teach the specific structures responsible for dehydrogenase activity, nor provide guidance as to what changes in the structure can be made in order to retain the dehydrogenase activity. Protein chemistry is unpredictable in the current state of art. For example, Wang, J. et al. 2000 J. Biol. Chem. 275 (1): 507-513 provide evidence that even a single amino acid change converts a potent enzyme into a protein without any enzymatic activity (see Fig. 3, 4, and 5). Bowie et al (Science, 1990, 247:1306-1310) teach that an amino acid sequence encodes a message that determines the shape and function of a protein and that it is the ability of these proteins to fold into unique three-dimensional structures that allows them to function and carry out the instructions of the genome and further teaches that the problem of predicting protein structure from sequence data and in turn utilizing predicted structural determinations to ascertain functional aspects of the protein is extremely complex. (col 1, p. 1306). Bowie et al further teach that while it is known that many amino acid substitutions are possible in any given protein, the position within the protein's sequence where such amino acid substitutions can be made with a reasonable expectation of maintaining function are limited. Certain positions in the sequence are critical to the three dimensional structure/function relationship and these regions can tolerate only conservative substitutions or no substitutions (col 2, p. 1306). The sensitivity of proteins to alterations of even a single amino acid in a sequence are exemplified by Burgess et al (J of Cell Bio. 111:2129-2138, 1990) who teach that replacement of a single lysine residue at position 118 of acidic fibroblast growth factor by glutamic acid led to the substantial loss of heparin binding, receptor binding and biological activity of the protein.



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Lazar et al (Molecular and Cellular Biology, 1988, 8:1247-1252) teach that conservative substitutions in a protein do not lead to retaining biological activity of a protein. Lazar et al teach that transforming growth factor alpha, replacement of aspartic acid at position 47 with non-conservative residue alanine did not affect biological activity while replacement with a conservative residue, glutamic acid sharply reduced the biological activity of the mitogen. These references demonstrate that even a single amino acid substitution or "conservative" amino acid substitution in a protein will often dramatically affect the biological activity and characteristics of a protein.

Further, an acyl-CoA dehydrogenase, which the specification speculates SEQ ID NO:2 to be, does not appear to be promiscuous in terms of its substrate: Aoyama et al, (1994, J. Biol. Chem. vol. 269, pages 19088-94) teach that an acyl-CoA dehydrogenase uses a specific substrate. Note Table 1 at page 19094. Since the claims also involve measuring dehydrogenase activity, the knowing structural nature of the SEQ ID NO:2 substrate is also necessary to practice the invention but the specification does not provide any guidance on the structure of the substrate.

Considering the state of art and the scope of the claims, and the limited teachings of the specification, it is concluded that undue experimentation would be required to practice the invention.

### ***Conclusion***

No claim is allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Misook Yu whose telephone number is 703-308-2454. The examiner can normally be reached on 8 A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Misook Yu  
October 29, 2003

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